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10/627,646	07/28/2003	Steven M.H. Wallman	10392-460042	3617
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Bradley J. Meier KENYON & KENYON Suite 700 1500 K Street, N.W. Washington, DC 20005				
EXAMINER				
FU, HAO				
ART UNIT		PAPER NUMBER		
3696				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/627,646

Applicant(s)

WALLMAN, STEVEN M.H.

Examiner

HAO FU

Art Unit

3696

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 03/31/2009
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Remarks

In the remarks and claims filed on 04/29/2009, the applicants amended claims 1-4 by adding the feature "wherein said economically unviable trading order includes at least one trading order for a fractional share of on investment" and "maintaining in a separate account up to one single shares of each investment in which there is at least one trading order for a fractional share of said each investment".

The feature, "wherein said economically unviable trading order includes at least one trading order for a fractional share of on investment", is explicitly disclosed in the Pender reference, as previously pointed out by the examiner.

The feature, "maintaining in a separate account up to one single shares of each investment in which there is at least one trading order for a fractional share of said each investment", was introduced in the newly added claims filed on 06/30/2008 (claim 8, 16, and 20, which are now canceled). This feature was considered as allowable subject matter over the cited prior art, in the Office Action mailed on 02/18/2009. However, after close scrutiny of the original specification, the examiner can not find any support for such feature. Therefore, new matter rejection must be raised at this time. Should applicants desire to pursue this limitation, filing of Continuation-In-Part (CIP) with the supported specification is appropriate at this time.

Furthermore, the applicants have not taken an action to fix the deficits under U.S.C. 101. Therefore, the examiner maintains the U.S.C. 101 rejection on claims 2 and 3. Claims 5-20 are now canceled.

Claim Rejection – USC 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The feature, "maintaining in a separate account up to one single shares of each investment in which there is at least one trading order for a fractional share of said each investment", was introduced in the newly added claims filed on 06/30/2008 (claim 8, 16, and 20, which are now canceled). This feature was considered as allowable subject matter over the cited prior art, in the Office Action mailed on 02/18/2009. However, after close scrutiny of the original specification, the examiner can not find any support for such feature.

Claim Rejection – USC 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 2 and 3 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Based on Supreme Court precedent a method claim must (1) be tied to another statutory class of invention (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (see at least *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)). A method claim that fails to meet one of the above requirements is not in compliance with the statutory requirements of 35 U.S.C. 101 for patent eligible subject matter. Here claims 2, 3, 5, and 10-17 fail to meet the above requirements since there is not a sufficient tie to another statutory class.

Claim Rejection – USC 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 1-7 10-11, 14-15, 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.: 5,126,936 to Champion et al., in view of Perham (John C Perham, Stock Exchange Explains Its Pay-As-You-Go Plan, *Barron's national Business and Financial Weekly*, Aug 24, 1953) and Dibben (Margaret Dibben, Just let your fingers d' the dealing Cut-price services mean that calling your broker is no longer

the preserve of the idle rich, The Guardian, Oct 23, 1994), and further in view of Newberry (Jon Newberry, Bye bye broker, ABA Journal, Mar 1998, Vol. 84 pg. 90, 1pgs) and Pender (Kathleen Pender, Stock Trading, San Francisco Chronicle, Jun 23, 1986).

As per claim 1, Champion teaches a method for managing an investment account for a customer associated with a sponsoring organization comprising the steps of (see column 3, line 8-12):

interacting with the customer over a computer network (see Fig 2, "modem" and "computer" suggest that customers can be reached over a computer network) to create a portfolio of investments that satisfy a plurality of restrictions on investment activity of the customer while meeting pre-defined investment needs of the customer (see column 4, line 6-21, and line 31-46, also see column 5, line 40-52);

establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment (see column 5, line 47-57).

transmitting a portfolio of desired investments over the computer network for execution (see column 5, line-8-15, and line 47-57).

Examiner notes however, Champion does not teach aggregating including combining at least one economically unviable order for an investment.

Perham teaches establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment, including combining at least one economically unviable order for an investment (It is evident in the Perham reference that the broker has been combining all the orders into one order for execution over the network (i.e. Exchanges) for each stock in the 1950s. Perham discloses "It (brokerage firm) then combines all the orders for that same stock and sends them to one broker for execution on the Exchange floor, as a round lot as possible; if not, as an odd lot. The ultimate aim is, combining the mites of investors from here and there, to give each of them the benefit of the lower commission charge on round lots." It seems that Perham also anticipates the idea of combining economically unviable order for an investment. The prior art anticipates the idea of combining fractional shares, or economically unviable order, into an viable order by stating, "The fundamental idea is to boost trading volume, to the benefit of both member

firms and the Exchange itself, by allowing a potential investor of small means to begin buying stock before he has accumulated, say, the entire \$155 needed for one share of American Telephone & Telegraph. This would be done by pooling payments made periodically by several small investors". Given more than four decades of development, it should be apparent that the present claim feature would have been well known at the time of invention).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization for the benefit of lowering commission charge on economically unviable trades and making these trades viable.

Newberry also teaches the feature of allowing customers to purchase economically unviable trade, such as a fractional shares (see page 1, "DRIPs offer the key advantage of molding an investment plan to an investor's own financial means and goals. He notes that DRIPs allow individuals to buy either full or fractional shares").

Pender also teaches combining economically unviable order for an investment, wherein said economically unviable trading order includes at least one trading order for a fractional share of one investment (see page 2, "For small investors who still want to pick their own stocks, Merrill Lynch offers a "share builder account" that lets clients buy shares or fractional shares in increments as small as \$25. 'We pool all money in share builder accounts and buy stocks the next morning,' said Merrill Lynch spokesman Jim Lynch; the examiner notes Merrill Lynch is a stock brokerage firm, and thus the prior art supports the argument that broker and brokerage firm can aggregate economically unviable trades).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include combining at least one economically unviable order for an investment for the benefit of molding an investment plan to an investor's own financial means and goals.

Notes: None of the cited prior art discloses the feature "maintaining in a separate account up to one single shares of each investment in which there is at least one trading order for a fractional share of said each investment". However, this feature is not supported by the original specification. Therefore, no patentable weight is granted for this feature.

As per claim 2, Champion teaches a method for managing a plurality of investment accounts (see column 4, line 46-51, it is implied that there is a plurality of accounts), each of which is associated with a third party user (see column 4, line 66-67, it is implied that each account is associated with a third party user), comprising the steps of:

receiving data from the user regarding the plurality of investment accounts, the data defining the amount and types of investments to be included in each investment account (see column 4, line 56-65);

aggregating the plurality of investment accounts into a single portfolio of investments for the user (see column 4, line 46-51, aggregating a total level of risk for all customer accounts is analogous to aggregating plurality of accounts into a single portfolio then performing risk analysis);

establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment (see column 5, line 47-57).

analyzing the single portfolio to determine a risk/reward characteristic of the single portfolio (see column 4, line 46-51).

Examiner notes however, Champion does not teach establishing an aggregate portfolio of investments from the third party user and from a plurality of other users, wherein said establishing an aggregate portfolio includes combining orders for investments from the third party user and the plurality of other users into a single order for each investment, including combining at least one economically unviable order for an investment.

Examiner notes however, Champion does not teach aggregating including combining at least one economically unviable order for an investment.

Perham teaches establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment, including combining at least one economically unviable order for an investment (It is evident in the Perham reference that the broker has been combining all the orders into one order for execution over the network (i.e. Exchanges) for each stock in the 1950s. Perham discloses "It (brokerage firm) then combines all the orders for that same stock and sends them to one broker for execution on the Exchange floor, as a round lot as possible; if not, as an odd lot. The ultimate aim is, combining the mites of investors from here and there, to give each of them the benefit of the lower commission charge on round lots." It seems that Perham also anticipates the idea of combining economically unviable order for an investment. The prior art anticipates the idea of combining fractional shares, or economically unviable order, into an viable order by stating, "The fundamental idea is to boost trading volume, to the benefit of both member firms and the Exchange itself, by allowing a potential investor of small means to begin buying stock before he has accumulated, say, the entire \$155 needed for one share of

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American Telephone & Telegraph. This would be done by pooling payments made periodically by several small investors". Given more than four decades of development, it should be apparent that the present claim feature would have been well known at the time of invention).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization for the benefit of lowering commission charge on economically unviable trades and making these trades viable.

Newberry also teaches the feature of allowing customers to purchase economically unviable trade, such as a fractional shares (see page 1, "DRIPs offer the key advantage of molding an investment plan to an investor's own financial means and goals. He notes that DRIPs allow individuals to buy either full or fractional shares").

Pender also teaches combining economically unviable order for an investment, wherein said economically unviable trading order includes at least one trading order for a fractional share of one investment (see page 2, "For small investors who still want to pick their own stocks, Merrill Lynch offers a "share builder account" that lets clients buy shares or fractional shares in increments as small as \$25. 'We pool all money in share builder accounts and buy stocks the next morning,' said Merrill Lynch spokesman Jim Lynch; the examiner notes Merrill Lynch is a stock brokerage firm, and thus the prior art supports the argument that broker and brokerage firm can aggregate economically unviable trades).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include combining at least one economically unviable order for an investment for the benefit of molding an investment plan to an investor's own financial means and goals.

Notes: None of the cited prior art discloses the feature "maintaining in a separate account up to one single shares of each investment in which there is at least one trading order for a fractional share of said each investment". However, this feature is not supported by the original specification. Therefore, no patentable weight is granted for this feature.

As per claim 3, Champion teaches a method for creating a plurality of separate investment accounts while managing the plurality of separate investment accounts as a single investment portfolio (see column 3, line 30-40), comprising the steps of:

establishing a separate file for each of the plurality of separate investment accounts (see column 3, line 30-34, and column 4, line 6-10);

establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the

plurality of other customers into a single order for each investment (see column 5, line 47-57).

analyzing the plurality of separate investment accounts as if the plurality of separate investment accounts were a single investment portfolio, the analysis including at least one of: a risk level analysis (see column 4, line 46-51), a diversification analysis (see Fig 1), a concentration analysis and a sector exposure analysis (see column 3, line 46-47) for the single portfolio.

Examiner notes however, Champion does not teach aggregating including combining at least one economically unviable order for an investment.

Perham teaches establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment, including combining at least one economically unviable order for an investment (It is evident in the Perham reference that the broker has been combining all the orders into one order for execution over the network (i.e. Exchanges) for each stock in the 1950s. Perham discloses "It (brokerage firm) then combines all the orders for that same stock and sends them to one broker for execution on the Exchange floor, as a round lot as possible; if not, as an odd lot. The ultimate aim is, combining the mites of investors from here and there, to give each of them the benefit of the lower commission charge on round lots." It seems that Perham also anticipates the idea of combining economically unviable order for an investment. The prior art anticipates the idea of combining fractional shares, or economically unviable order, into an viable order by stating, "The fundamental idea is to boost trading volume, to the benefit of both member firms and the Exchange itself, by allowing a potential investor of small means to begin buying stock before he has accumulated, say, the entire \$155 needed for one share of American Telephone & Telegraph. This would be done by pooling payments made periodically by several small investors". Given more than four decades of development, it should be apparent that the present claim feature would have been well known at the time of invention).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization for the benefit of lowering commission charge on economically unviable trades and making these trades viable.

Newberry also teaches the feature of allowing customers to purchase economically unviable trade, such as a fractional shares (see page 1, "DRIPs offer the key advantage of molding an investment plan to an investor's own financial means and goals. He notes that DRIPs allow individuals to buy either full or fractional shares").

Pender also teaches combining economically unviable order for an investment, wherein said economically unviable trading order includes at least one trading order for

a fractional share of one investment (see page 2, "For small investors who still want to pick their own stocks, Merrill Lynch offers a "share builder account" that lets clients buy shares or fractional shares in increments as small as \$25. 'We pool all money in share builder accounts and buy stocks the next morning,' said Merrill Lynch spokesman Jim Lynch; the examiner notes Merrill Lynch is a stock brokerage firm, and thus the prior art supports the argument that broker and brokerage firm can aggregate economically unviable trades).

It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include combining at least one economically unviable order for an investment for the benefit of molding an investment plan to an investor's own financial means and goals.

Notes: None of the cited prior art discloses the feature "maintaining in a separate account up to one single shares of each investment in which there is at least one trading order for a fractional share of said each investment". However, this feature is not supported by the original specification. Therefore, no patentable weight is granted for this feature.

As per claim 4, Champion teaches a method for managing an investment account of a plurality of customers associated with a sponsoring organization (see column 3, line 8-12, and line 30-34), comprising the steps of:

establishing a plurality of restrictions on the investment activity of the plurality of customers associated with the sponsoring organization (see column 4, line 6-21, and line 31-46);

interacting with a first customer over a computer network (see Fig 2, "modem" and "computer" suggest that customers can be reached over a computer network) to identify a portfolio of investments that satisfy the plurality of defined restrictions while meeting customer defined investment needs of the first customer (see column 4, line 6-21, and line 31-46, also see column 5, line 40-52);

establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment (see column 5, line 47-57).

transmitting a plurality of trade requests over a computer network identifying a plurality of investments in the aggregate portfolio (see column 5, line-8-15, and line 47-57).

Examiner notes however, Champion does not teach aggregating including combining at least one economically unviable order for an investment.

Perham teaches establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization, wherein said aggregating includes combining orders for investments from the customer and the plurality of other customers into a single order for each investment, including combining at least one economically unviable order for an investment (It is evident in the Perham reference that the broker has been combining all the orders into one order for execution over the network (i.e. Exchanges) for each stock in the 1950s. Perham discloses "It (brokerage firm) then combines all the orders for that same stock and sends them to one broker for execution on the Exchange floor, as a round lot as possible; if not, as an odd lot. The ultimate aim is, combining the mites of investors from here and there, to give each of them the benefit of the lower commission charge on round lots." It seems that Perham also anticipates the idea of combining economically unviable order for an investment. The prior art anticipates the idea of combining fractional shares, or economically unviable order, into a viable order by stating, "The fundamental idea is to boost trading volume, to the benefit of both member firms and the Exchange itself, by allowing a potential investor of small means to begin buying stock before he has accumulated, say, the entire \$155 needed for one share of American Telephone & Telegraph. This would be done by pooling payments made periodically by several small investors". Given more than four decades of development, it should be apparent that the present claim feature would have been well known at the time of invention).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include establishing an aggregate portfolio of investments from the first customer and from a plurality of other customers of the sponsoring organization for the benefit of lowering commission charge on economically unviable trades and making these trades viable.

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It would have been obvious to one of ordinary skill in the art at the time of invention to modify the reference to include combining at least one economically unviable order for an investment for the benefit of molding an investment plan to an investor's own financial means and goals.

Notes: None of the cited prior art discloses the feature "maintaining in a separate account up to one single shares of each investment in which there is at least one trading order for a fractional share of said each investment". However, this feature is not supported by the original specification. Therefore, no patentable weight is granted for this feature.

Claims 5-20 (Canceled).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HAO FU whose telephone number is (571)270-3441. The examiner can normally be reached on Mon-Fri/Mon-Thurs 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tom Dixon can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/THOMAS A DIXON/
Supervisory Patent Examiner, Art Unit 3696

Hao Fu
Examiner
Art Unit 3696

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/Hao Fu/
Examiner, Art Unit 3696